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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,328	09/29/2000	James A. Belmont	99104CON	1547
7590 Michelle B Lando Esq Cabot Corporation Law Department 157 Concord Road Billerica, MA 01821-7001			EXAMINER OH, TAYLOR V	
			ART UNIT 1625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/04/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/672,328

Applicant(s)

BELMONT, JAMES A.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10,12-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,12-27,29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

Final Rejection

The Status of Claims

Claims 1-3, 5-10, 12-27, and 29 are pending.

Claims 1-3, 5-10, 12-27, and 29 have been rejected.

The objection to the Specification

The objection of the specification has been withdrawn due to the modification made in the specification.

Claim Rejections-35 USC 112

1. Applicants' argument filed 10/10/06 have been fully considered but they are not persuasive.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of 1-3, 5-10, 12-27, and 29 has been maintained due to applicants' failure to modify the claim languages in the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 2, 4 and 11 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification and cancellation of the claims in the amendment.

Claim Rejections-35 USC 103

2. The rejection of Claims 1, 21-22, and 24-27 under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 5,571,311) has been maintained with a reason of record on 4/18/06.

Applicants' Argument

3. The applicants argue the following issues:
- a. the claimed invention is not devoid of synthetic procedures or directional guidance that would enable one skilled in the art to prepare the disclosed pigment products and does provide data essential for how all starting materials can be used;
 - b. Belmont et al does not teach two different types of attached groups, such as one steric group and one organic group; furthermore, there is no showing an ionic group having an amphiphilic group just like the claimed amphiphilic group.

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The applicants' argument have been noted, but these arguments are not persuasive.

First, with regard to the first argument, the Examiner has noted applicants' argument. However, on contrary to applicants' assertion, in the instant case, the claim encompasses any pigments and organic ionic groups and amphiphilic counterion groups without any final concrete chemical structure. For example, the specification provide only 6 particular examples to represent the claimed invention of numerous modified pigments; applicants have merely listed the groups of pigments in the specification which were invented by other inventors. This does not give the current inventors a right to own all the possible combinations of pigments known in the art. Those examples can not be the representatives of the entire modified pigments. Thus, the specification herein have failed to provide sufficient working examples to support the claimed modified pigments and the method of making them. Therefore, the rejection is still relevant to the issue of the claimed invention.

Second, with regard to the second argument, the Examiner has noted applicants' argument. However, on contrary to applicants' assertion, in the instant case, the claim encompasses any pigments and organic ionic groups and amphiphilic counterion groups without any final concrete chemical structure. Furthermore, there are no definitive structures for the steric or the organic ionic group with one amphili amphiphilic group in the claims. This means that applicants claim any form or type of the steric and /or the organic ionic group with one amphili amphiphilic group. Thus, Belmont et al does teach a pigment such as carbon black attached at least one organic groups substituted with an ionic (see col. 5 ,lines 5-6) or an ionizable functional group having at least an amphiphilic ,such as quaternary phosphonium groups (see col.

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5 ,lines 59-60) and /or an carbon black attached at least one organic groups having one branched C1-C12 alkyl group (see col. 5 ,lines 26-28) as the steric group. From these teachings, it seems reasonable that the bulky group such as an aromatic group with branched alkyl groups can be used as either the organic and/or the steric group depending on the choice of the skilled artisan in the art. Therefore, if the skilled artisan in the art had desired to formulate the pigment containing the one steric group, and one organic group with one amphiphilic group, it would have been obvious to the skilled artisan in the art to be motivated to use the Belmont's et al substituted aromatic compounds as the organic group having the steric groups along with quaternary phosphonium groups (see col. 5 ,lines 59-60). Therefore, the prior art is till relevant to the claimed compound due to the absence of the finite chemical structure for the pigment product.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor Victor Oh, MSD,LAC
Primary Examiner
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12/26/06